

Remarks

Claims 15-17 and 19 were pending in the subject application. By this Amendment, the applicants have amended claim 15. No new matter has been added by this amendment. Accordingly, claims 15-17 and 19 are now before the Examiner for consideration. Support for the claim amendments can be found throughout the specification and the claims as originally filed.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. The amendments should not be taken to indicate the applicants' agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

The Office Action indicates that the subject specification does not comply with 37 C.F.R. §1.77. Due to the formatting changes that the Examiner has requested, the applicants are attaching a substitute specification, with marked-up copy showing the formatting amendments that have been made. Further the applicants have attached a Statement under 37 C.F.R. §1.125(b).

Claims 15-17 and 19 have been rejected under 35 U.S.C. §102(e) as being anticipated by Drayna *et al.* (U.S. 20040248123). The applicants respectfully traverse this ground for rejection to the extent that it might be applied to the claims that are now presented for examination.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra; Kalman v. Kimberly-Clarke*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

Drayna *et al.* disclose phenylthiocarbamide (PTC) as an agonist of a receptor that is not identical to hTAS2R38 (SEQ ID NO: 1). Further, the Drayna *et al.* reference does not disclose the hTAS2R38 specific agonists that are used in the process according to amended independent claim 15. Therefore, the subject-matter of claim 15 is novel over the Drayna *et al.* reference. Dependent claims 16 and 17 and independent claim 19 directly or indirectly incorporate the use of the novel agonists specified in claim 15, thus the subject-matter of these claims is also novel with respect to the Drayna *et al.* reference.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based on the Drayna *et al.* reference.

Claims 15, 17 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Drayna *et al.* (U.S. 20040248123). The applicants respectfully traverse this ground for rejection because the Drayna *et al.* reference does not disclose or suggest the applicants' unique and advantageous process as set forth in the claims that are now presented for examination.

The Drayna *et al.* reference contains no teaching or suggestion of the use of the novel bitter receptor agonists now specified in claim 15. Thus, the process according to independent claim 15 and the subject matter claimed in dependent claims 16 and 17 and independent claim 19 which all directly or indirectly involve the use of said hTAS2R38 specific agonists would not have been obvious to a person skilled in the art.

It is well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield an applicant's invention does not make the modification or application obvious unless "there was an apparent reason to combine the known elements in the fashion claimed" by the applicant. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007). Furthermore, an applicant's invention is not "proved obvious merely by demonstrating that each of its elements was, independently, known in the (purported) prior art." *Id.*

Furthermore, as expressed by the CAFC, to support a §103 rejection, “[b]oth the suggestion and the expectation of success must be founded in the prior art ...” *In re Dow Chemical Co.* 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). One finds neither the suggestion nor the expectation of success in the cited reference. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103.

In view of the foregoing remarks, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik  
Patent Attorney  
Registration No. 31,794  
Phone: 352-375-8100  
Fax No.: 352-372-5800  
Address: P.O. Box 142950  
Gainesville, FL 32614-2950

DRS/la

Attachment: Marked-up Version of Substitute Specification  
Clean copy of Substitute Specification  
Statement under 37 C.F.R. §1.125(b)